

Docket No.: 08226/0203220-US0

## REMARKS

Claims 1-3 and 28-51 are currently pending. The present Final Office Action dated September 25, 2006 ("the FOA") has rejected all of the Claims. No claims are amended, no claims have been added and no claims are cancelled. No new matter has been added. For at least the reasons discussed below, Applicants submit that pending claims 1-3 and 28-51 are patentable for the reasons discussed in detail below.

Claim Rejections under 35 U.S.C. §112, first paragraph

Claims 1-3 and 28-51 are rejected under 35 U.S.C. § 112, first paragraph as failing to comply with the enablement requirement. Specifically, the FOA states that there is no support for the term “conferencing link,” because the word “conference” nor any of its derivatives occur in the Applicant’s Specification. Applicants respectfully respond that the FOA appears to mix the enablement requirement with the written description requirement. While both are specified under 35 U.S.C. § 112, first paragraph, they are separate and distinct from each other. (MPEP § 2161.)

Applicants respectfully contend that the lack of a specific word in the specification is not sufficient basis to reject the claims for lack of enablement. “In order to make a rejection, the examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention . . . [E]xaminer must provide a reasonable explanation why the scope of protection provided by a claim is not adequately enabled by the disclosure.” (MPEP § 2164.04, citing *In re Wright*, 999 F.2d 1557, 1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993).)

Instead, the FOA appears to assert a reason to support a lack of written description. However, Applicants respectfully note that “[t]he subject matter of the claim need not be described literally (i.e., using the same terms or *in haec verba*) . . .” (MPEP § 2163.02.) The term “conferencing link” does not involve a departure from, addition to, or deletion from the disclosure of the application as filed. The description clearly allows persons of ordinary skill in the art to recognize that Applicants invented what is claimed. For example, the specification and drawings explain an embodiment in clearly related terms such as “call,” “caller’s communication,”

“communication channel,” “communication session,” “communication link,” “conversation,” “telephone network,” and the like. (See e.g., pg. 13, lines 19-32 and Figs. 1 and 5-8.) The figures also clearly show such links. Thus, the specification meets both the enablement and written description requirements. Accordingly, Applicants respectfully request that the rejection of Claims 1-3 and 28-51 under 35 U.S.C. §112, first paragraph, be withdrawn.

Claim Rejections under 35 U.S.C. §103 over Dialpad.com in view of Landsman

Claims 1-3 and 28-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dialpad.com (Dialpad.com screenshots from 8/17/2000 and prior obtained via www.archive.org/The Wayback Machine) in view of Landsman et al. (U.S. Patent No. 6,314,451, “Landsman”). Applicants respectfully argue that the FOA makes assertions that are not supported by these references, and thus, a prima facie case of obviousness is not established.

First, the FOA asserts that Dialpad.com discloses the claim limitation of downloading configuration instructions for controlling broadcast of at least one audio advertisement based at least in part on a status of a conferencing link. The FOA does not cite any specific language or portion of Dialpad.com to support this assertion. Instead, the FOA broadly asserts that “Dialpad.com discloses a local Java applet downloaded to the user device that displays or plays . . . the audio advertising [and] it is obvious that the local Java applet can receive or has the necessary instructions for . . . playing the audio advertising.” (FOA, pg. 5, lines 8-12 and pg. 12, lines 11-15.) The FOA further asserts that “the Java applet receives instructions for the advertisements/audio advertisements that are displayed through the local Java applet.” (FOA, pg. 5, lines 14-15 and pg. 12, lines 17-18.) Again, the FOA does not cite any specific language or portion of Dialpad.com to support these assertions. Applicants respectfully disagree that Dialpad.com (or Landsman) disclose or suggest these assertions and thus do not disclose or suggest the required claim limitation.

Dialpad.com states that “[o]ne single banner bar appears on the applet and each Web page on the site. The ads rotate every 30 seconds . . .” (Dialpad.com, April 4, 2000, pg. 16, para. 4.) There is no disclosure or suggestion that a banner bar or a banner ad includes audio

advertising. This is especially true for the years 2000 and 1999 when the Dialpad.com and Landsman references were prepared. There is also no disclosure or suggestion that the banner bar or banner ad are controlled based on a status of a conferencing link. On the contrary, the banner ads are rotated every 30 seconds, without any regard to a call status. This teaches away from the banner ads including an audio advertisement, because they would interfere with a call in progress.

Dialpad.com also states that “[t]he company has already begun to generate ad revenues from its rotating banners on the Dialpad.com applet and Web site. Additional revenue will come this quarter from audio ad bumpers on the front and back end of all calls . . .” (Dialpad.com, January 12, 2000, pg. 21, para. 3.) There is no disclosure or suggestion that the Java applet controls broadcast of the audio ad bumpers. In addition, there is no disclosure or suggestion that the Java applet can detect the status of call. On the contrary, Dialpad.com states that “a server-based module [] manages the concurrent call control process through the Company’s scalable server network.” (Dialpad.com, January 12, 2000, pg. 22, para. 5.) Because the server-based module controls calls, it controls broadcast of the audio ad bumpers. Otherwise, the audio ad bumpers would interfere with a call. Thus, Dialpad.com teaches away from the claim limitation of downloading configuration instructions (e.g., applet) for controlling broadcast of at least one audio advertisement based at least in part on a status of a conferencing link.

The FOA also asserts that Landsman provides more explicit disclosure concerning downloading of information and that there is nothing in Dialpad.com or Landsman that would prevent the combination from downloading information. (See, FOA, pg. 5, lines 16-20 and pg. 12, line 22 through pg. 13, line 2.) MPEP Section 2143.01 (III) states that the “fact that references can be combined or modified is not sufficient to establish *prima facie* obviousness.” Even if these assertions are true, in arguendo, Landsman does not disclose or suggest the missing limitation that downloaded configuration instructions control broadcast of at least one audio advertisement based at least in part on a status of a conferencing link. As with Dialpad.com, Landsman does not disclose or suggest that its downloaded instructions can detect a call status. Thus, instructions downloaded by Landsman’s could not control broadcast of an audio advertisement based no a status of a conferencing link. If Landsman’s instructions did control such broadcast, without knowing the

status of the call, the instructions would interfere with the call. Consequently, there is no benefit or motivation to combine Landsman with Dialpad.com.

The FOA further asserts that “the conclusion of obviousness may be made from common knowledge and common sense of a person of ordinary skill in the art without any specific hint of suggestion a particular reference.” (FOA, pg. 11, line 26 through pg. 12, line 1, citing *In re Bozek*, 416 F.2d 1385, USPQ 545 (CCPA 1969).) However, “[a]s the court held in *Zurko*, an assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support.” (MPEP § 2144.03 A., citing *In re Zurko*, 258 F.3d 1379, 1385, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001).) “The standard of review applied to findings of fact is the ‘substantial evidence’ standard under the Administrative Procedure Act (APA).” (MPEP § 2144.03.) “[C]ommon knowledge and common sense . . . are not the specialized knowledge and expertise contemplated by the Administrative Procedure Act. Conclusory statements such as those here provided do not fulfill the agency’s obligation.” (MPEP § 2144.03 A., citing *In re Lee*, 277 F.3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002).) It is unclear which fact(s) FOA considers common knowledge and/or common sense. Nevertheless, “[i]t is never appropriate to rely solely on ‘common knowledge’ in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based.” (MPEP § 2144.03 A., citing *In re Zurko*, 258 F.3d 1379, 1385, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001).)

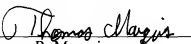
In summary, neither Dialpad.com nor Landsman, alone or in combination, teach or suggest all of the limitations of independent Claim 1. For at least the above reasons, independent Claim 1 is patentable over the combination of Dialpad.com and Landsman. Independent Claims 37, 44, and 50 are rejected for the same reasons as Claim 1. For at least the reasons above, independent Claims 37, 44, and 50 are also patentable over the combination of the Dialpad.com and Landsman references. Accordingly, Applicants respectfully request that the rejection of the independent claims under 35 U.S.C. §103(a) be withdrawn. At the very least, Applicants respectfully request that the finality of the rejections be withdrawn and specific factual evidence be identified, so that Applicants have a fair opportunity to address the rejections. It is well settled that dependent claims are patentable for at least the same reasons as the independent claims from which they depend.

Accordingly, Applicants respectfully request that the rejection of the dependent claims under 35 U.S.C. §103(a) also be withdrawn.

In view of the above amendment, applicant believes the pending application is in condition for allowance. Should any further aspects of the application remain unresolved, the Examiner is invited to telephone Applicants' attorney at the number listed below.

Dated: November 27, 2006

Respectfully submitted,

By 

Thomas R. Marquis

Registration No.: 46,800

DARBY & DARBY P.C.

P.O. Box 5257

New York, New York 10150-5257

(206) 262-8917

(212) 527-7701 (Fax)

Attorneys/Agents For Applicant